

Reference Sheet : Proving use

How do you control - and overcome - the difficulties of "proving use" of a trade mark recently acquired from another company?

- **TM 7: Intellectual Property Office**
URL: <https://www.gov.uk/government/publications/notice-of-opposition-and-statement-of-grounds>
- **Sec 6A of the Trade Marks Act 1994**
URL: <https://www.legislation.gov.uk/ukpga/1994/26/section/6A>
- **2 Questions:**
 1. Was the registration or protection for the earlier trade mark completed 5 years or more before the application date?
 2. Has the trade mark been used in the 5 year period ending on the date of application?
- **Non- use as a defence in infringement proceedings - Sec 11A of the Trade Marks Act 1994**
URL: <https://www.legislation.gov.uk/ukpga/1994/26/section/11A>

Sec 11A

(1) The proprietor of a trade mark is entitled to prohibit the use of a sign only to the extent that the registration of the trade mark is not liable to be revoked pursuant to section 46(1)(a) or (b) (revocation on basis of non-use) at the date the action for infringement is brought.

(2) Subsection (3) applies in relation to an action for infringement of a registered trade mark where the registration procedure for the trade mark was completed before the start of the period of five years ending with the date the action is brought.

(3) If the defendant so requests, the proprietor of the trade mark must furnish proof—

- (a) that during the five-year period preceding the date the action for infringement is brought, the trade mark has been put to genuine use in the United Kingdom by or with the consent of the proprietor in relation to the goods and services for which it is registered and which are cited as justification for the action, or
- (b) that there are proper reasons for non-use.

(4) Nothing in subsections (2) and (3) overrides any provision of section 46, as applied by subsection (1) (including the words from "Provided that" to the end of subsection (3)).

What "use" is it anyway?

- **Sec 6A(4)(a) of the Trade Marks Act 1994**
 - (a) ... use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor) and
 - (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

“Genuine use”

- **Stichting BDO & Ors v BDO Unibank, Inc & Ors [2013] EWHC 418 (Ch) - Hon Mr Justice Arnold** URL: <https://www.bailii.org/ew/cases/EWHC/Ch/2013/418.html#para51>

"(1) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely 'token', which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider*, [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(3) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22]-[23]; *Sunrider*, [70]-[71].

(4) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no de minimis rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]"